

**REMARKS**

**I. Status of Claims**

Claims 1-63 are currently pending. Claims 1, 54, 59, 62, and 63 are amended herein to recite that the composition has a “pulverulent to pasty texture.” Support for this amendment can be found in the specification as originally filed, for example, in paragraphs [012]-[019]. Accordingly, no new matter is introduced by this amendment.

**II. Rejections Under 35 U.S.C. § 103(a)**

As a preliminary matter, Applicants note that the Examiner has withdrawn the rejection of the claims under 35 U.S.C. § 103 over U.S. Patent No. 7,094,842. See Advisory Action at 2.

Claims 1-63 are rejected as allegedly unpatentable under 35 U.S.C. § 103 over U.S. Patent No. 6,403,704 to Bara (“the ‘704 patent”), U.S. Patent No. 6,689,345 to Jager Lezer (“the ‘345 patent”), U.S. Patent No. 6,565,862 to Bara (“the ‘862 patent”), and U.S. Patent No. 6,184,277 to Bara (“the ‘277 patent”). See Office Action at 3-5; Advisory Action at 2.<sup>1</sup> Applicants respectfully traverse these rejections for at least the following reasons.

In order to satisfy the initial burden of establishing a *prima facie* case of obviousness, the Examiner is instructed by the MPEP to make a “clear articulation of the reason(s) why the claimed invention would have been obvious.” MPEP § 2141 (rev. 6, Sept. 2007). The Supreme Court, in its recent decision in *KSR Int'l Co. v. Teleflex*,

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<sup>1</sup> The Examiner did not address the ‘277 patent in the Advisory Action; therefore Applicants are unsure if this rejection is still pending. Applicants have addressed this rejection herein, but request clarification as to the status of this rejection.

further instructs that the analysis supporting a rejection under 35 U.S.C. § 103 "should be made explicit." 127 S.Ct. at 1741, 82 U.S.P.Q.2d at 1396 (emphasis added) (citing *In re Kahn*, 441 F.3d 977, 988 (Federal Circuit, 2006) ("[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness"). Applicants assert that these criteria have not been met here for at least the following reasons.

The '704, '862, and '345 patents

The Examiner argues that while the '704, '862, and '345 patents do not teach the claimed ratios of organopolysiloxane to particulate phase (see, e.g., claim 1), these patents "teach the claimed components . . . for the same purpose" and "[t]he amounts of individual components described in the prior art overlap with that of the instant claims. Thus, the scope and content of the cited prior art is the same as that of the instant invention and hence preparing a cosmetic composition [as claimed] . . . by optimizing the amounts of the individual components (thus varying their ratios) would have been within the scope of a skilled artisan. . . ." Office Action at 3. Applicants respectfully disagree.

Specifically, as discussed in the instant specification at pages 1-2, paragraph [007]:

The inventors have found, unexpectedly, that the use of a binder comprising water and particles of an at least partially crosslinked elastomeric solid organopolysiloxane makes it possible to obtain a composition with a novel texture, from pasty to pulverulent, which exhibits excellent cosmetic properties, for example, in terms of freshness. Furthermore, such compositions can be advantageously shaped by pressing in a customary cosmetic container.

As discussed in the specification and previously on the record, and as recited in the presently amended claims, the instant invention relates to compositions having a "pulverulent to pasty texture," which is imparted by the claimed ratio of organopolysiloxane to particulate phase. None of the '704, '862, and '345 patents teach or suggest the desirability of a composition having such a pasty to pulverulent texture, much less the ratio of organopolysiloxane to particulate phase required to achieve such a texture. Without any specific guidance from these references, it cannot be said that one skilled in the art would have been motivated to "optimize" the compositions of the '704, '862, and '345 patents by picking and choosing the particular claimed ratio of organopolysiloxane to particulate phase to achieve the present invention, as alleged by the Examiner. Applicants reiterate that the Examiner has not given any explicit reason why one of ordinary skill in the art would have been motivated, either by the cited art or by knowledge generally available to the skilled artisan, to modify the composition of any of the '704, '862, and '345 patents by incorporating therein the organopolysiloxane and particulate phase in amounts sufficient to arrive at the claimed ratio (*i.e.*, from 0.4:1 to 1.8:1 as recited in *e.g.*, claim 1). Thus, the Examiner has not met his burden in establishing a *prima facie* case of obviousness based on these patents.

Applicants' position is further supported by Table 1 below, which lays out the disclosed concentrations of organopolysiloxane and particulate phase and the resulting range of ratios suggested to the skilled artisan by such disclosures:

**Table I**

<b>U.S. Patent No. 6,403,704</b>			
<i>Component</i>	<i>Concentration</i>	<i>Cited passage</i>	<i>Ratio</i>
Particulate phase: dye stuffs (pigments, nacres, fillers)	0-60 wt %	col. 7, ll. 5-12	Organopolysiloxane:particulate 99:0 - 1:60
Organopolysiloxane	1-99 wt%	col. 4, ll. 31-33	
<b>U.S. Patent No. 6,565,862</b>			
<i>Component</i>	<i>Concentration</i>	<i>Cited passage</i>	<i>Ratio</i>
Particulate phase: coloring material (pigments, pearlescent agents, fillers)	0-60 wt %	col. 7, ll. 14-22	Organopolysiloxane:particulate 99:0 - 1:60
Organopolysiloxane	1-99 wt%	col. 4, ll. 49-51	
<b>U.S. Patent No. 6,689,345</b>			
<i>Component</i>	<i>Concentration</i>	<i>Cited passage</i>	<i>Ratio</i>
Particulate phase: dye stuffs (pigments, nacres, fillers)	0-60 wt %	col. 9, ll. 42-47	Organopolysiloxane:particulate 700:1 - 1:800
Particulate phase: fibers	0.1-20 wt %	col. 4, ll. 41-46	
Organopolysiloxane	0.1-70 wt%	col. 6, ll. 11-12	

As indicated in Table 1 above, the '704, '862, and '345 patents teach such widely varied concentrations for the organopolysiloxane and particulate phase, it cannot reasonably be said that such broad disclosures would lead one of ordinary skill in the art to optimize the concentrations to arrive at the presently claimed ratio (*i.e.*, from 0.4:1 to 1.8:1 as recited in *e.g.*, presently amended claim 1). Absent specific guidance from the references, which are all silent with respect to a composition having a pulverulent to pasty texture as claimed, these all-encompassing ranges cannot reasonably be said to provide any motivation to the skilled artisan to seek out the particular claimed ratio of organopolysiloxane to particulate phase.

Moreover, as laid out in the Reply After Final filed January 18, 2008, the specific examples provided by the cited references teach compositions which lack both a pasty

to pulverulent texture and the claimed ratio of organopolysiloxane to particulate phase.

See Reply After Final at 4-7; *see also* Table 2 provide below.

Table 2

U.S. Patent No. 6,403,704	
Example	Ratio Organopolysiloxane/particulate
Example 2 (foundation)	2.59
Example 3 (eye shadow)	2.02
U.S. Patent No. 6,565,862	
Example 2 (foundation)	2.59
U.S. Patent No. 6,689,345	
Example 1 (foundation)	0.25
Example 2 (tinted body gel)	3.36

As shown above, none of the relevant examples of the '704, '862, and '345 patents teach the presently claimed organopolysiloxane/particulate phase ratio (*i.e.*, ranging from 0.4:1 to 1.8:1 as recited in, *e.g.*, presently amended claim 1). Thus, the only specific guidance provided by the '704, '682, and '345 patents, other than the general disclosures of these references, does not lead the skilled artisan to the claimed ratio, but rather, leads the artisan away from the claimed ratio. As such, it cannot be said that the disclosures of these patents would motivate one skilled in the art to "optimize" the compositions of the patents by picking and choosing the particular claimed ratio of organopolysiloxane to particulate phase to achieve the present invention.

For at least these reasons, the Examiner has not established a *prima facie* case of obviousness and the rejections over the '704, '862, and '345 patents are improper. Therefore, Applicants respectfully request that these rejections be withdrawn.

The '277 patent

As noted above, because the Examiner did not specifically address the '277 patent in the Advisory Action, Applicants have addressed this rejection herein out of an abundance of caution.

The '277 patent teaches oil-based gel compositions (see col. 1, lines 20-22) comprising at least one organopolysiloxane combined with a fatty phase. See abstract. The '277 patent does not teach or suggest compositions comprising an aqueous suspension of organopolysiloxane particles. However, the Examiner takes the position that the '277 patent does teach organopolysiloxane in an aqueous phase because it "teaches [the] addition of gelling agents in an aqueous phase (col. 4), which is exemplified as [a] gelled dispersion composition for skin care." Office Action at 5. Applicants respectfully disagree.

While the '277 patent does mention that the composition may include an optional aqueous phase, it nowhere mentions or suggests incorporating an organopolysiloxane into such phase. Indeed, to the contrary, the '277 patent teaches that the organopolysiloxanes are used to gel the fatty phase, and are generally conveyed in at least one hydrocarbon oil and/or a silicone oil. See col. 2, ll. 34-47.

Furthermore, as argued previously, the '277 patent is completely silent with respect to the claimed ratio of organopolysiloxane to particulate phase. Moreover, because the '277 patent is directed to gel compositions, one skilled in the art would not be motivated to modify these composition by incorporating a particulate phase in an amount suitable to produce a composition having a pasty to pulverulent texture, as presently claimed.

Therefore, the Examiner has failed to establish a *prima facie* case of obviousness over the present invention and this rejection is improper. Applicants respectfully request that this rejection be withdrawn.

### **III. Obviousness-Type Double Patenting Rejections**

As a preliminary matter, Applicants note that the Examiner has withdrawn the rejection of the claims on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims of U.S. Patent No. 6,565,862 in view of Applicants Terminal Disclaimer filed January 15, 2008. *See* Advisory Action at 2.

Claims 1-63 remain rejected on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 1-63 of the '345 patent. *See* Office Action at 2-3; Advisory Action at 2.

The Examiner concedes that the '345 patent does not teach the ratios of the instant claims, but asserts that it would have been obvious to one skilled in the art to optimize the compositions of the '345 patent to achieve the present invention. *See id.* Applicants respectfully traverse the rejection for at least the following reasons.

According to MPEP § 804 II.B.1., an obviousness-type double patenting rejection employs similar guidelines to those used for a statutory obviousness rejection under 35 U.S.C. § 103, except that only the claims themselves are analyzed and the disclosure of the cited patent or application may not be used as the basis of the rejection. Because the '345 patent was filed before the instant application was filed, the "one-way" test of obviousness is used to determine "whether the invention defined in a claim in the application is an obvious variation of the invention defined in a claim" in the

'862 patent. See MPEP § 804 II.B.1.(a) (*citing In re Berg*, 46 U.S.P.Q.2d 1226 (Fed. Cir. 1998)). The proper application of this test, in light of the established general principles for obviousness, reveals that claims 1-63 of this application are not obvious over claims 1-63 of the '345 patent.

Specifically, under the one-way test for obviousness of *Berg*, to make a proper obviousness-type double patenting rejection, the Office must show that the presently claimed invention is an obvious variation of the invention claimed in the '345 patent. To establish a *prima facie* case of obviousness, the Office must show that the claims of the '345 patent teach or suggest all of the limitations of the rejected claims and that there is some reason why one of ordinary skill in the art would have been led to modify the prior art to arrive at the presently claimed invention. See MPEP §§ 2143 and 804 II.B.1. Applicants assert that the Office has failed to satisfy these requirements here.

The Examiner admits that the claims of the '345 patent do not teach or suggest all of the limitations of the rejected claims, specifically, the ratios recited in the rejected claims. Applicants assert that the '345 patent would not lead one skilled in the art to modify its compositions to arrive at the presently claimed invention. Specifically, as discussed above with respect to the rejections under § 103, the present invention relates to compositions having a pasty to pulverulent texture, which is imparted by the claimed ratio of organopolysiloxane to particulate phase, whereas the '345 patent provides no guidance with respect to the desirability of a composition of this texture nor the organopolysiloxane to particulate phase ratio required to achieve such a texture. The Examiner has failed to provide any reason why the skilled artisan, without any guidance from the '345 patent, would modify the composition of the '345 patent to arrive

at the presently claimed composition. Thus, it cannot be said that one skilled in the art would have been motivated to "optimize" the compositions of the '345 patent to achieve the present invention, as alleged by the Examiner. Accordingly, this rejection is improper and Applicants respectfully request that this rejection be withdrawn.

**IV. Conclusion**

In view of the foregoing remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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By: \_\_\_\_\_

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